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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,496	07/28/2000	Mark Bresnan	F-192	3808
919	7590	11/22/2005	EXAMINER	
PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			DIXON, THOMAS A	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/628,496

Applicant(s)

BRESNAN ET AL.

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21,23-40 and 42-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-21,23-40 and 42-52 is/are allowed.
- 6) ☒ Claim(s) 53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment of November 2, 2005 has been entered. (Claims 22 and 41 should be listed as Cancelled) The arguments are not convincing regarding the new matter.
2. The amendment filed 6/5/01 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as previously argued.

Also as previously argued, claim 38 is rejected as introducing new matter as previously argued.

Applicant is required to cancel the new matter in the reply to this Office Action.

Offer to Surrender Patent

3. Applicant's offer to surrender the patent 5,873,073 is acceptable.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claim 53 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in

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content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Allowable Subject Matter

5. Claims 1, 15, 20, 38 are allowable.

6. The following is an examiner's statement of reasons for allowance:

As per Claim 1.

The prior art of record, specifically, Harmon et al ('706), Cordery et al ('249), Murko et al ('255), Humes et al ('120), or Baker et al ('305) do not disclose or fairly teach:

- d) transmitting said print job to a terminal node wherein said terminal node is not co-located with, nor under the control of said first node;
- e) receiving said print job at said terminal node, said terminal node for receiving said print job and for directing said print job to a mail production means for producing said mail piece, said mail production means further comprising:
 - (i) a first printer; and
 - (ii) a second printer;
- g) printing on said second printer said document is printed in accordance with characteristics selected at said first node.

As per Claim 15.

The prior art of record, specifically, Harmon et al ('706), Cordery et al ('249), Murko et al ('255), Humes et al ('120), or Baker et al ('305) do not disclose or fairly teach:

- b) transmission means for transmitting said mailing to a second data processing means wherein said second data processing means is not co-located with, nor under control of, said first data processing means;
- c) second data processing means for receiving said mailing and downloading said mailing to a plurality of printer means comprising a first printer and a second printer;
- e) second printer means comprising said second printer for printing said document to media selected at said first data processing means.

As per Claim 20.

The prior art of record, specifically, Harmon et al ('706), Cordery et al ('249), Murko et al ('255), Humes et al ('120), or Baker et al ('305) do not disclose or fairly teach:

- creating a document and storing said document in electronic form;

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transmitting said document, said address list and said characteristics to a terminal node wherein said terminal node is not co-located with, nor under the control of, said first node;

printing said document in accordance with one or more of said characteristics selected at said first node; and

providing said printed envelope with evidence of postage payment.

As per Claim 38.

The prior art of record, specifically, Harmon et al ('706), Cordery et al ('249), Murko et al ('255), Humes et al ('120), or Baker et al ('305) do not disclose or fairly teach:

a system for producing a mailpiece that has a second data processing means that is not co-located or under the control of a first data processing means which electronically receive selected documents and direct the selected documents to a mail production means that includes printing means and that print the selected document, an envelope for the selected document and means for printing the envelope with evidence of postage payment.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon
Primary Examiner
Art Unit 3639

November 05